

REMARKS

Claims 1-22 are pending in this application. Claims 23 and 24 have been withdrawn. Claim 5 has been amended to insert "claim" before "4" to correct an inadvertent typographical omission. Claim 6 is cancelled as it is redundant over claim 1.

The rejection of claims 1-22 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,649,174 is maintained, since allegedly, although the conflicting claims are not identical, they are not patentably distinct from each other because the instant independent claims encompass the patent claim regarding the film forming agent and ratio. To obviate this rejection, the Applicants are directed to submit a terminal disclaimer in compliance with 37 CFR 1.321(c), as the conflicting patent is commonly owned with the present application. The Examiner has noted that "Applicants stipulate that the rejection remains in effect until such time as they amend or file a TD".

Claims 1, 2, 4-9, and 11-19 are rejected under 35 U.S.C. 103(a) allegedly as being unpatentable over Touzan et al. (hereinafter "the '496 reference") in view of Shah et al. (hereinafter "the '155 reference"). The rejection, repeated from the office action of November 16, 2006, states in relevant part:

"Touzan et al teach a two phase composition for cleansing containing a demixing agent (title, abstract). An aqueous and separate oily phase in a ratio of 30:70-60:40 is disclosed (abstract). Isohexadecane, liquid paraffins, and silicone oils including cyclopentadimethylsiloxane are disclosed (column 4 lines 1-20). Colorants are specified (column 4 line 25). Shah et al teach a polyvinylpyrrolidone/vinyl acetate copolymer at 1-5% to maintain pigments in suspension (column 4 lines 37-57). Applicants disclose this polymer on page 2 line 33. It would have been obvious to one of ordinary skill to add a polyvinylpyrrolidone/vinyl acetate copolymer to the composition of Touzan et al for the beneficial effect of maintaining colorants in suspension in view of Shah et al."

The Examiner further states the following, in the rejection in the office action of August 1, 2007, in response to the Applicants' arguments:

"Applicants argue that the demixer in Touzan et al is not a film-former, however, the polymer in Shah et al. is such, according to

applicants. Applicants argue that Touzan et al disclose only 0.05% colorant whereas Shah et al teach much larger amounts of pigment. However, Touzan et al is not limited to the disclosed amount. Thus, if one of ordinary skill wished to increase the amount of pigment in the Touzan et al composition, Shah et al teaches the addition of polyvinylpyrrolidone/vinyl acetate copolymer to maintain such larger amounts of colorant in suspension. Applicants argue that PVP is known as a film former and suspension stabilizer, teaching away from a role as a demixer, however, the polymer being added here is polyvinylpyrrolidone/vinyl acetate. Even if the latter polymer is known as a film former and suspension stabilizer, Shah et al teaches its use as a suspension stabilizer for colorants. The motivation to combine need not be applicants'. Applicants argue that one of ordinary skill would be unlikely to add another ingredient to an emulsion because of the difficulty in creating a stable emulsion. However, Touzan et al do not teach such view of the presence of a demixer. Applicants' proposition that the demixing function of Touzan et al will be compromised by addition of the Shah et al polymer, a stabilizer, is mere speculation. Applicants further argue that Touzan et al concerns an oil and water composition, whereas Shah et al concerns two miscible aqueous phases. That is, they are not analogous. Applicants further argue that, therefore, one of ordinary skill would not have a reasonable expectation of success. However, Shah et al is used only for its disclosure of the use of the polymer to maintain colorants suspended, at least in the aqueous phase."

This rejection is again respectfully traversed. The present invention, as recited in claim 1, is directed to a dual phase liquid cosmetic composition comprising an aqueous phase and an oil phase in the ranges set out in the claim. The phases are separate from one another before and after being mixed at the time of use. The composition contains as a demixing agent, a film forming agent. In a preferred embodiment of the present invention, as recited in claim 8, the film forming agent is non-cationic. In a further preferred embodiment of the present invention, as recited in claims 21 and 22, the film former is present in the oily phase of the composition. The '496 reference also teaches a dual phase composition having an aqueous phase and an oily phase. However, the aqueous phase contains a particular demixing agent, alkyl dimethylbenzyl ammonium ("benzalkonium") chloride, which is not a film forming agent. The '155 reference teaches a dual phase composition; however, unlike the composition of the '496 reference, the two phases of the '155 reference are both aqueous and therefore miscible. One aqueous phase of the '155 reference is a gel phase, while the other phase is a color phase. As disclosed at column 8, lines 2-14 of the '155 reference, the color phase is manipulated and disposed in the container against a background of the gel phase such that the color

phase appears completely engulfed in the gel. For use, the two phases are mixed to form a homogenous composition. Thus, the two phases are kept separated before use, and are therefore not subsequently demixed after use. As further taught in the '155 reference, each phase can contain PVP. The gel phase, as taught at column 5, lines 55-65, includes a water soluble resin as a thickener, preferably of the crosslinked acrylic acid polymer family, and can be PVP. The color phase contains a protective colloid to maintain the pigment in suspension. PVP and PVP/VA copolymer may be used for this purpose.

It is the Examiner's assertion that it would have been obvious to one of ordinary skill in the art to incorporate PVP in the compositions of the '496 reference to maintain colorants in suspension in view of the '155 reference, and thus arrive at the present invention. The Applicants cannot agree with the Examiner's reasoning. The colorant, as taught in the '155 reference, is added to the color phase in the amount of 1-60 weight percent. However, in each of the 19 examples described in columns 8-15 of the '155 reference, the colorant is present in the color phase in an amount in the range of from about 30-40%. PVP is the protective colloid present in each example. It is the presence of the PVP which maintains the pigments in suspension in the color phase and prevents the bleeding of the colorant into the gel phase. As discussed at column 7, lines 66-68, the two phases are disposed in discrete side by side phases in the container. Unlike the compositions in the '155 reference, the use of pigment in the dual phase compositions of the '496 reference is disclosed in only one example, Example 4. The amount of the colorant used is a mere 0.05 weight percent. The '496 reference is otherwise silent on the amount of pigment which may be used. Therefore, since in the entire reference, there is only the teaching to use 0.05 weight percent of colorant, the amount of colorant which is taught or suggested as useful and/or desirable in the '496 reference compositions must be limited to the example. This amount is 20 times less than the minimum 1% colorant disclosed in the '155 reference, and it is at least 600 times less than the amounts employed in the examples in the '155 reference. Clearly, in contrast to the reasoning set forth by the Examiner, a formulator of two-phase compositions of the type described in the '496 reference, having ordinary skill in the art, would not have appreciated any need for, nor any benefit to, introducing the PVP disclosed in the '155 reference, where it is used for suspending an extraordinarily large amount of pigment in one aqueous phase of a composition so as to prevent the colorant from bleeding into the other aqueous phase of the composition, into the two-phase compositions of the '496

reference which optionally contain a mere 0.05 weight percent colorant. The Examiner nevertheless maintains that the '496 reference is not limited to 0.05 weight percent pigment and that if one skilled in the art "wanted to" increase the amount of pigment, the '155 reference teaches the use of a film former to suspend the substantially larger amounts of pigment. The Examiner now appears to take the position that one skilled in the art would only introduce the film former of the '155 reference into the compositions of the '496 reference together with a large amount of colorant. However, The Examiner has provided no logical support for his reasoning that one skilled in the art would desire to do so, and has only used only hindsight obtained from knowledge of the Applicants' invention in an attempt to arrive at the Applicants' invention. Although one skilled in the art could possibly attempt to add a relatively large amount of colorant and a film former to the compositions of the '496 reference, there is neither any suggestion in the patent that this would be desirable nor would one skilled in the art believe that there would be a reasonable expectation of success in doing so; that is, one skilled in the art could not predict that the introduction of the additional ingredients would not negatively affect the properties of the '496 composition, in particular, the demixing capability of the composition. The '155 reference employs PVP to suspend pigments, teaching away from the achievement of the present invention wherein the film former performs a demixing function. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that was taken by the claimed invention. *In re Gurley*, 31 USPQ2d 1130, 1131 (CAFC 1994). It is therefore unclear to the Applicants how it can be only mere speculation, according to the Examiner, that the addition of a known suspension stabilizer and emulsion stabilizer together with a relatively large amount of colorant to the compositions of the '496 reference would be expected by those skilled in the art to interfere with the demixing capability of the compositions, such that the compositions would tend to remain in their emulsified state. The Examiner simply has not shown that the Applicants have combined the prior art elements according to known methods, or made a simple substitution of one known demixing agent for another, which would yield predictable results. The Examiner has not shown that one of ordinary skill in the formulation art would have any reasonable expectation that the addition of the film former of the '155 reference to the compositions of the '496 reference would not interfere with the demixing capability of the '496 compositions and/or would successfully perform the demixing function.

Furthermore, the '496 reference and the '155 reference compositions clearly possess entirely different properties, the former being a two-phase composition including aqueous and oily phases which are mixed temporarily and rapidly demixed, and the latter being a dispersion of two aqueous phases which are mixed to homogeneity for use and which are not subsequently demixed. Those of ordinary skill in the art would appreciate that formulating a stable emulsion is a formidable task and that one does not easily introduce a further ingredient into such stable emulsion without some prediction as to the behavior of that ingredient in the stable emulsion composition; that is, some indication that the further ingredient will not upset the delicate balance achieved in the stable emulsion. Similarly, formulating a composition which forms an emulsion only temporarily upon mixing and rapidly demixes cannot be any less difficult. In fact, the '496 reference, in column 1, lines 19-25, describes the difficulty in the prior art of forming a two-phase composition, which after shaking, does not tend to remain in the emulsified state, and addresses that problem in the art. In view of the fact that PVP is a known suspension stabilizer and emulsion stabilizer, the skilled formulator would predict that PVP would interfere with the demixing function of the dual phases of the compositions of the '496 reference. The use of the PVP for suspending is divergent and contrary to demixing. The Examiner, however, considers this reasoning of the Applicants to be merely speculative, and suggests that the '496 reference does not support the Applicants' position, since the reference successfully incorporates a demixing agent. However, from a fair reading of the reference, it would be understood by those skilled in the art that it does not disclose whether stable emulsions are difficult to formulate, but that a particular type of ingredient can be used to destabilize an otherwise stable emulsion. The references fail to teach that a film former which is a known suspension and emulsion stabilizer could have a demixing effect in a two-phase composition.

Since neither the '496 reference nor the '155 reference nor their combined teachings disclose or suggest a dual phase composition comprising, as a demixing agent, an effective amount of a non-cationic film forming agent, the present invention as claimed in claim 8 also is patentable over the prior art. The film forming agents disclosed in the '155 reference are cationics. Therefore, assuming for the sake of argument, that the combination of the '496 reference with the '155 reference is a proper one, the combination would not result in the invention of claim 8 which calls for a non-cationic film former as the demixing agent.

For all of the above reasons, it is considered that the Examiner has not established a *prima facie* case of obviousness, and that the rejection of the claims under §103(a) in view of the combined teachings in the '496 and the '155 references must be withdrawn.

Claims 1, 2, 4-8 and 10-22 also stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nagy et al (hereinafter "the '758 reference") in view of Grollier et al (hereinafter "the '095 reference"). The rejection which is restated from the official action of November 16, 2006, states in relevant part:

"Nagy et al teach a makeup removing composition comprising two phases and a demixing agent (abstract). A 30:70-70:30 ratio of oil to aqueous phase is disclosed (column 3, lines 12-14). Mixtures of cyclic silicones, dimethicone and a volatile C16 paraffin are specified (column 4, lines 33-53). Grollier et al teach two phase compositions comprising a cationic polymer for skin conditioning (abstract). Vinyl pyrrolidone-acrylamide copolymers are specified at 0.2-50% (column 8, lines 1-26, column 9, lines 20-24). Dimethylaminoethylmethacrylate is disclosed (column 8 line 59). Applicants disclose PVP/dimethylamino ethylmethacrylate on page 2 line 32. It would have been obvious to one of ordinary skill to add a vinylpyrrolidone-acrylamide copolymer to the composition of Nagy et al to achieve the beneficial effect of a skin conditioner in view of Grollier et al."

The Examiner further states the following, in the rejection in the office action of August 1, 2007, in response to the Applicants' arguments:

"Applicants argue that the suspension of cationic polymer in alcohol is known to be irritating to the eyes (no citation). However, Grollier et al do not teach an alcoholic phase. Applicants note that Nagy et al teach against incorporating a demixing agent into an oily phase, citing column 3 lines 4-5. However, Nagy et al merely prefer the aqueous phase, which is not a teaching away. Applicants' argument regarding the interference of a cationic polymer surfactant with a demixing agent is mere speculation. Applicants argue that neither Nagy et al nor Grollier et al teach the non-cationic film former of claims 8-9. However, as noted above, Grollier et al teach a polymer disclosed by applicants in their specification."

This rejection is again respectfully traversed. The '758 reference teaches a liquid dual phase cleansing composition comprising an oil phase and an aqueous phase, which are mixed temporarily at the time of use and rapidly demixed, and a specific class of cationic demixing agent, a quaternary nitrogen-containing ether substituted alkoxylated alkyl glucoside. The demixing agent, being water-soluble is preferably added

in the aqueous phase of the composition (column, 3, lines 4, 5 of the reference). The '095 reference teaches a non-detergent composition having two separately packaged compositions that are only mixed at the time of application; the composition being shaken to disperse the aqueous phase in the oily phase. Once mixed for use, the composition is not demixed. One of the liquid phases is an aqueous phase in which a cationic polymer is dissolved. The cationic polymer, as described at column 2, line 64 – column 9, line 14, includes vinylpyrrolidone acrylate or methacrylate copolymers of aminoalcohol. The other phase is an oily phase as disclosed at column 2, lines 16-23, which includes non-volatile oils. The '095 reference teaches against incorporating the cationic polymer into an oily phase. As taught and/or suggested in the reference, the desirable properties of the cationic polymer will be compromised if it is incorporated in an oily phase. Specifically, at column 1, lines 46-57, it is taught that, although it is possible to incorporate the cationic polymers in the oil phase, the effectiveness is very slight because their characteristic adherence to the skin or hair was inhibited in the oily medium.

Although the Examiner alleges that it would have been obvious to combine the teachings of the '758 and the '095 references to achieve the present invention, the Applicants cannot agree with this reasoning. The compositions of the '758 reference and the '095 reference clearly possess entirely different properties, the former compositions being dual phase compositions, including aqueous and oily phases which are mixed temporarily at the time of use and which rapidly demix, and the latter compositions which, when mixed at the time of use, form dispersions of an aqueous phase in an oily phase and which do not demix. As discussed above, with regard to the '496 and the '155 references, those of ordinary skill in the art of formulating emulsions would appreciate that formulating a stable emulsion is a formidable task and that one does not easily introduce a further ingredient into such stable emulsion without some prediction as to the behavior of that ingredient in the stable emulsion composition; that is, some indication that the further ingredient will not upset the delicate balance achieved in the stable emulsion. Similarly, those skilled in the art would appreciate that formulating a composition which forms an emulsion only temporarily upon mixing and rapidly demixes cannot be any less difficult. In view of the fact that the cationic polymers are known surfactants which lower the surface tension of water and help to stabilize emulsions, one skilled in the art would predict that the addition of the cationic polymers of the '095 reference to the stable emulsion of the '758 reference would interfere with the demixing

function of the dual phases of the compositions of the '758 reference. The use of the cationic polymers for stabilizing emulsions is divergent and contrary to demixing. One skilled in the art would not have had a reasonable expectation of success in arriving at the present invention by combining the teachings in these references.

Furthermore, the '095 reference clearly teaches providing separate aqueous and oily compositions which are not mixed until the time of use. The compositions are kept separate so that the cationic polymers present in the aqueous composition are kept separate from the oily composition until the time of use so as to retain the efficacy of the polymers to adhere to skin and hair. This is in contrast to the dual phase composition of the '758 reference (and the present invention) where, in use, the composition is mixed and rapidly demixed, with every use. This would effectively subject the cationic polymer in the aqueous phase to contact with the oily phase upon mixing again and again. In view of the teachings in the '05 reference, one skilled in the art would not incorporate the cationic polymers into the dual phase composition of the '758 reference.

Additionally, there is no teaching or suggestion in either reference to incorporate the cationic polymer into the oil phase of a dual phase composition, as recited in claim 21. As discussed above, the '758 reference teaches that, as the demixing agent is water-soluble, it is preferably added in the aqueous phase, but that the '095 reference strongly teaches against incorporating the film forming agent in the oily phase, since its efficacy in that phase is only slight. The Examiner responds that the '758 reference merely prefers the aqueous phase, which is not teaching away. Nevertheless, when the '758 and the '095 references are read together, as the Examiner would have one skilled in the art do, the overwhelming teaching is to incorporate the film former in the aqueous phase. This is a clear teaching away from Applicants' invention as defined in claim 21.

Furthermore, present claim 8 requires the demixing agent to be a non-cationic film forming agent. Claim 9 further specifies these non-cationic film forming agents. The '758 and the '095 references teach only cationic polymers as a demixing agent (the '758 reference) or as a conditioning agent (the '095 reference). Neither reference therefore can teach or suggest the present invention as claimed in claim 8 and its dependent claims which require a non-cationic film forming agent as the demixing agent. The Examiner merely responds that although the Applicants argue that neither reference teaches the non-cationic film former of claims 8-9, dimethylaminoethylmethacrylate is

disclosed in the '758 reference at column 8 line 59, while the Applicants disclose PVP/dimethylamino ethylmethacrylate on page 2 line 32 of the present specification. Nevertheless, the film former to which the Examiner refers is a cationic film former, while the Applicants' claim 8 calls for a non-cationic film former as a demixing agent. Therefore, the cited references fail to disclose the invention of the Applicants' claim 8.

For these reasons, it is considered that the Examiner has not established a *prima facie* case of obviousness, and that the rejection of the claims under §103(a) in view of the combined teachings of the '758 and '095 references should be withdrawn.

CONCLUSION

In view of the arguments presented above, in the present submission, the claims are believed to be in condition for allowance, and the issuance of a Notice of Allowance is respectfully requested.

Respectfully submitted,

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